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ELECTION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Edward E. KNAUS, Leonard I. WIEBE, and Kevin MORIN

Serial No. : 09/855,176

Group Art Unit: 1635

Filing Date : May 14, 2001

Examiner: Janet L. Epps

Title : **COMBINED USE OF NUCLEOSIDE
ANALOGUES AND GENE TRANSFECTION
FOR TISSUE IMAGING AND THERAPY**

Entity Status : Small Entity

Our Docket : RR-371 PCT/US CIP

CERTIFICATE UNDER 37 CFR 1.8 (a)

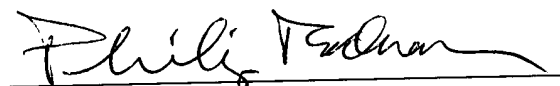
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Applicants' Attorney

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Office Action of September 27, 2002 concerning the subject patent application. If any fee is necessary for filing this Response, please debit our Deposit Account No. 18-1743.

REMARKS

Reconsideration of the restriction requirement is respectfully requested. Applicants provisionally elect, with traverse, the claims of Group I, identified as follows:

Group I: Claims 1-32 drawn to a method for monitoring the transfer of a foreign gene throughout a population of cells comprising detecting a labeled product, wherein said labeled product is the compound of claim 10 wherein X is ^{123}I , *classified in class 600, subclass 1.*

The examiner also determined that there are five other patentably distinct groups of invention in this application identified as follows:

Group II: Claims 1-11, 13-14, 16, 18, 20, 22, 24, 26, 28 and 30-32 drawn to a method for monitoring the transfer of a foreign gene throughout a population of cells comprising detecting a labeled product, wherein said labeled product is the compound of claim 10 wherein X is ^{124}I , *classified in class 600, subclass 1;*

Group III: Claims 1-11, 13-14, 16, 18, 20, 22, 24, 26, 28, and 30-32 drawn to a method for monitoring the transfer of a foreign gene throughout a population of cells comprising detecting a labeled product, wherein said labeled product is the compound of claim 10 wherein X is ^{131}I , *classified in class 600, subclass 1;*

Group IV: Claims 1-11, 30-32 drawn to a method for monitoring the transfer of a foreign gene throughout a population of cells comprising detecting a labeled product, wherein said labeled product is the compound of claim 10 wherein X is ^{75}Br , *classified in class 600, subclass 1;*

Group V: Claims 1-11, 30-32 drawn to a method for monitoring the transfer of a foreign gene throughout a population of cells comprising detecting a labeled product, wherein said labeled product is the compound of claim 10 wherein X is ^{76}Br ,
classified in class 600, subclass 1;

Group VI: Claims 1-11, 30-32, drawn to a method for monitoring the transfer of a foreign gene throughout a population of cells comprising detecting a labeled product, wherein said labeled product is the compound of claim 10 wherein X is ^{18}F ,
classified in class 600, subclass 1.

As noted above each of the six groups of invention segregated by the examiner are classified in class 600, subclass 1.

Applicants thus submit that since all groups of invention are in the same class and subclass there would be no unreasonable burden imposed on the examiner to conduct a search of all six groups simultaneously. Accordingly, it is believed that the following principles of MPEP § 803 are applicable to this situation:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The guidelines for MPEP § 803 indicate that

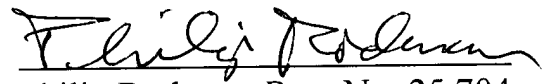
“...a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art or a different field of search as defined in MPEP § 808.02.”

Since there is no separate classification or separate status in the art of the six groups of invention segregated by the examiner it is submitted that there is no prima facie showing of serious burden on the examiner to search all of the six groups of invention.

Therefore, it respectfully requested that the examiner reconsider and withdraw the restriction requirement and examine all claims in this application.

In view of the foregoing remarks, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,


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